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OFFICE OF PETITIONS

In re Patent No. 7,037,060 :
Issue Date: May 2, 2006 :
Application No. 10/602,534 : **DECISION DISMISSING PETITION**
Filed: June 23, 2003 : **UNDER 37 CFR 1.78(a)(3)**
Attorney Docket No. 2863-2-1-3 :

This is a decision on the petition under 37 CFR § 1.78(a)(3), filed December 12, 2006, seeking to add a claim for priority under 35 U.S.C. § 120 to nonprovisional Application No. 09/558,307, filed April 25, 2000, and provisional Application No. 60/156,042, filed September 24, 1999, by way of a Certificate of Correction.

The petition is **DISMISSED**.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed nonprovisional and provisional applications was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and 37 CFR 1.78(a)(5)(ii) and further failed to include a proper reference to the prior-filed applications as required by 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) and 37 CFR 1.78(a)(5)(i) and (iii).

This case was filed June 23, 2003. Therefore, since this case was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed **nonprovisional** application after issuance of the application into a patent. See MPEP 1481.03.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) and (iii) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

This petition fails to satisfy item (1) above. In this regard, 37 CR 1.78(a)(5)(ii) requires that a claim for benefit of priority to a prior-filed provisional application must be submitted during the pendency of the application. A Certificate of Correction is not a valid mechanism for adding or correcting a priority claim under 35 U.S.C. § 119(e) after a patent has been granted on an application filed on or after November 29, 2000. *See* MPEP 1481.03. Therefore, as this application matured into Patent No. 7,037,060 on May 2, 2006, a claim for benefit of priority to the above-noted provisional application cannot now be added by way of a Certificate of Correction.

In view of the above, a renewed petition under 37 CFR 1.78(a)(3), along with a Certificate of Correction which deletes reference to provisional Application No. 60/156,042, must be submitted, if it is desired to still claim benefit of priority to nonprovisional Application No. 09/558,307.

Petitioner may wish to file a reissue application if it is desired to claim benefit of priority to provisional Application No. 60/156,042. *See* MPEP 1402.

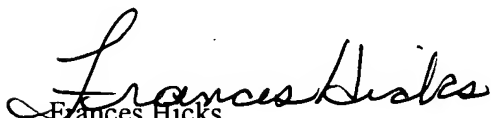
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Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.


Frances Hicks
Petitions Examiner
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